

02-12-01

IFW 1633

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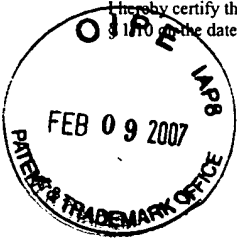
February 9, 2007

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By: Sarah M. Barnett
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PATENT

Customer No. 22,852

Attorney Docket No. 04853.0118-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Akira TSUKAMOTO et al.

Application No.: 10/505,474

§ 371(c) Date: August 24, 2004

International Filing Date: February 25, 2003

For: CELLULOLYTIC ENZYME GENE
AND USE THEREOF

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

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) Group Art Unit: 1633
)
) Examiner: Janet L. EPPS FORD
)
) Confirmation No.: 8917
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RESPONSE TO OFFICE ACTION

Applicants now respond to the Office Action mailed on January 11, 2007 ("Action").

The Office required restriction under 35 U.S.C. §§ 121 and 372, alleging that the "groups of inventions . . . are not so linked as to form a single general inventive concept under PCT Rule 13.1." Action at page 2. The Office required Applicants to elect a single invention to which the claims must be restricted as follows:

Group I: claim 3, allegedly "drawn to a method for treating woodchips comprising preparing a DNA encoding an antisense RNA substantially complementary to the cellulolytic enzyme: cellobiose dehydrogenase;"

Group II: claim 4, allegedly "drawn to a method for treating woodchips comprising preparing a DNA encoding an antisense RNA substantially complementary to the cellulolytic enzyme: cellobiohydrolase I;"

- Group III: claim 5, allegedly “drawn to a method for treating woodchips comprising preparing a DNA encoding an antisense RNA substantially complementary to the cellulolytic enzyme: cellobiohydrolase II;”
- Group IV: claim 6, allegedly “drawn to a method for treating woodchips comprising preparing a DNA encoding an antisense RNA substantially complementary to the cellulolytic enzyme: an endoglucanase gene belonging to enzyme family 61;”
- Group V: claim 7, allegedly “drawn to a method for treating woodchips comprising preparing a DNA encoding an antisense RNA substantially complementary to the cellulolytic enzyme: an endoglucanase gene belonging to enzyme family 12;”
- Group VI: claim 8, allegedly “drawn to a method for treating woodchips comprising preparing a DNA encoding an antisense RNA substantially complementary to the cellulolytic enzyme: an endoglucanase gene belonging to enzyme family 5;” and
- Group VII: claim 9, allegedly “drawn to a method for treating woodchips comprising preparing a DNA encoding an antisense RNA substantially complementary to the cellulolytic enzyme: an endoglucanase gene belonging to enzyme family 9.”

Id. The Office also indicated that “[c]laims 1-2, and 10-14 are considered to link invention groups I-VII. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claims, claims 1-2 and 10-14. Upon the allowance of the linking claims, the restriction requirement of the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application” *Id.* at page 2-3.

Applicants elect, with traverse, Group II (claim 4). Applicants respectfully note that, since the Office indicated that claims 1, 2, and 10-14 are considered linking claims, they must be examined with, and thus are considered part of, the invention elected. *See* M.P.E.P. § 809 (Rev. 5, Aug. 2006). Accordingly, claims 1, 2, 4, and 10-14 must be examined together as the elected invention (with traverse) of Group II.

Applicants traverse the restriction requirement and respectfully assert that the requirement is improper. The Office alleged that “Groups I-VII are drawn to distinct methods for treating woodchips, and methods for producing a pulp, comprising the preparation and use of an antisense RNA targeting a distinct cellulolytic enzyme, woodchips and pulp obtained from these methods. Therefore, Groups I-VII are considered to read on multiple categories of invention (specifically, multiple methods and multiple products), therefore as per 37 CFR § 1.475(a)-(d), applications containing claims drawn to more than one categories of invention (as defined by section (b)) are not considered to have unity of invention (see particularly section (c)).” *Id.* at page 3.

To the extent that the Office relies on 37 C.F.R. § 1.475(b) as a basis for restriction, Applicants respectfully assert that the Office has misapplied the rule, and therefore, the restriction is improper. 37 C.F.R. § 1.475(b) provides that “[a]n international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of [product and process for manufacture; or product and process of use; or product, process for manufacture, and use; or process and apparatus; or product, process, and apparatus].” The Office has restricted claims 3-9 to Groups I-VII, and indicated that claims 1, 2, and 10-14 are linking claims. Each of claims 3 (Group I), 4 (Group II), 5 (Group III), 6 (Group IV), 7 (Group V), 8 (Group VI), and 9 (Group VII) ultimately depend from claim 1, and therefore, include all of the elements of claim 1, which is directed to “[a] method for treating woodchips. . . .” Therefore, each of the claims of the restricted Groups is drawn to a single category of invention, methods for treating woodchips, and not to “multiple methods and multiple products,” as the Office alleged. Accordingly, the restriction of the claims to Groups I-VII is improper.

In addition, § 1.475(c) states that “[i]f an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention **might not** be present.” (emphasis added). To the extent that the Office relies on this section of the rule as a basis for restriction, Applicants respectfully note that the rule merely suggests that “unity of invention might not be present.” Accordingly, it is incumbent upon the Office to provide a rationale supporting the alleged lack of unity of invention. Nowhere did the Office provide such a rationale under § 1.475(c).

Notwithstanding the Office’s failure to provide a rationale to support the alleged lack of unity of invention, Applicants respectfully assert that it would be eminently feasible for the examiner to search and examine all of claims 1-14 together. This is because, even though claims 3-9 recite different cellulolytic enzyme genes, each of the different cellulolytic enzyme genes provides an enzyme that can decompose cellulose. *See, e.g.*, Specification at page 13, fourth paragraph. And each of the different cellulolytic enzyme genes is used in methods for treating woodchips according to the claims. Thus, because of the overlapping activity (decompose cellulose) of the different cellulolytic enzyme genes as recited in the claims, and the overlapping methods of use (treating woodchips) as recited in the claims, it would be eminently feasible for the Office to search and examine claims 1-14 together.

Moreover, Applicants note that the PCT Searching Authority did not consider the claims to lack unity of invention, and was able to search all 14 claims together. *See* “International Search Report for PCT Application No. PCT/JP03/02058, dated May 27, 2003,” a copy of an English translation of which was submitted with an Information Disclosure Statement filed in the present application on November 16, 2004. This further supports Applicants’ assertion above that it would be eminently feasible for the Office to search and examine claims 1-14 together.

In the alternative, Applicants submit that, for at least the same reasons as provided above, at least Group II (claim 4, which recites cellobiohydrolase I) and Group III (claim 5, which recites cellobiohydrolase II) should be examined together.


In conclusion, Applicants respectfully assert that the restriction requirement is improper at least for the reasons stated above and request withdrawal of the restriction of Groups I-VII. Accordingly, Applicants respectfully request that claims 1-14 be searched and examined together. In the alternative, Applicants request at least withdrawal of the restriction of Groups II-III. Applicants also respectfully remind the Office of the requirement that linking claims be examined with the elected invention. Accordingly, in the alternative, Applicants respectfully request that at least claims 4 and 5, along with linking claims 1, 2, and 10-14 be searched and examined together.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 9, 2007

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